

REMARKS

Applicants respectfully request that the non-statutory double patenting rejection¹ asserted in the Office Action be held in abeyance in light of its provisional character, and also until subject matter in the present application is disposed of as allowable.

As reasoned below, Applicants respectfully note that U.S. Patent 5,856,514 (hereinafter "the '514 patent") is not an anticipatory reference of the presently claimed subject matter. Furthermore, it is respectfully submitted that the '514 patent does not establish a *prima facie* case of obviousness in regard to the presently claimed subject matter.

The pending claims recite in full or in part, *inter alia*, "wherein ... G is C₃₋₆ alkenediyl or C₃₋₆ alkanediyl, optionally substituted with hydroxy, halogen, C₁₋₅ alkoxy, C₁₋₅ alkyl, oxo, hydroximino, CO₂R^k, R^kR^lN, R^kR^lNCO₂, (L)-C₁₋₄ alkylene-, (L)-C₁₋₅ alkoxy, N₃, or [(L)-C₁₋₅ alkylene]amino; each R^k and R^l is independently hydrogen, C₁₋₅ alkyl, C₃₋₅ alkenyl, phenyl, benzyl, phenethyl, or C₁₋₅ heterocyclyl; alternatively R^k and R^l can be taken together to form an optionally substituted 4- to 7-membered heterocyclic ring, which ring may be saturated, unsaturated or aromatic; L is amino, mono- or di-C₁₋₅ alkylamino, pyrrolidinyl, morpholinyl, piperidinyl homopiperidinyl, or piperazinyl, wherein available ring nitrogens may be optionally substituted with C₁₋₅ alkyl, benzyl, C₂₋₅ acyl, C₁₋₅ alkylsulfonyl, or C₁₋₅alkoxycarbonyl". Claim 1.

The features provided by the foregoing recitation are not disclosed in the '514 patent, including compounds 15 and 22 in the table shown in col. 10 therein. Because of at least this difference between the disclosure provided by the '514 patent and the pending claims, the '514 patent may not read on the presently claimed subject matter, and thus the '514 patent does not

¹ U.S. Serial number 09/927,188, cited in the Office Action, is presently issued as U.S. Patent 6,635,633, issued on October 21, 2003.

anticipate the presently claimed subject matter. Applicants respectfully request that the rejection under 35 U.S.C. § 102 in light of the '514 patent be withdrawn.

As reasoned above, the '514 patent does not disclose the presently claimed subject matter. Furthermore, as reasoned below, the '514 patent does not provide any suggestion or motivation for the synthesis of the compounds within the scope of the pending claims.

Therefore, the '514 patent may not establish a *prima facie* case of obviousness for the pending claims.

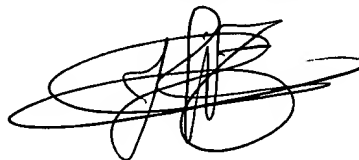
The '514 patent discloses "arylpyrazole fungicides", and more specifically "derivatives of the family of 3-arylpyrazoles, processes for their preparation, the compositions containing them and their use for protecting plants against fungal diseases." The '514 patent, col. 1, *ll.* 9-12. This patent reports results that are characterized therein as "clearly show[ing] the good fungicidal properties of the derivatives according to the invention against plant fungal diseases due to fungi belonging to the most varied families". The '514 patent, col. 16, *ll.* 1-4. Another use of the compounds of the '514 patent is reported therein as being "for the control of plant fungal diseases by preventive or curative treatment, on the foliage or the propagation material, of the plants or of their place of growth." The '514 patent, col. 20, *ll.* 42-45.

An element in determining obviousness of a new chemical compound is the motivation of one having ordinary skill in the art to make it. Such motivation is related to the properties or uses one skilled in the art would expect the compound to have, if made. The '514 patent, with the described uses and properties of its compounds, does not provide any teaching or indication that the compounds and/or the methods within the scope of the pending claims would have the properties and/or uses disclosed herein. No common-property presumption rises from the mere similarity between some moiety of some of the compounds disclosed in the '514 patent, and some moiety of some of the compounds within the scope of the pending claims.

For at least the reasons provided herein, the '514 patent does not establish a *prima facie* case of obviousness regarding the presently claimed subject matter. Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

Applicants respectfully request favorable consideration of the present Response to place the present application in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'J. Juanós i Timoneda', written in a cursive style.

By: Jesús Juanós i Timoneda, PhD
Reg. No. 43,332

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-1513
Dated: January 26, 2004